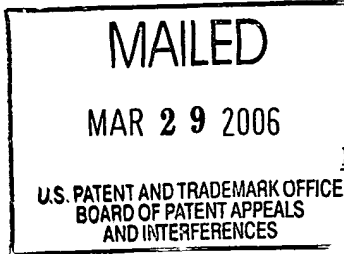


UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte WILFRIED JUD, RUDOLF JANACEK  
and JOACHIM PIETZSCH

Application No. 10/083,110

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on February 14, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

On June 18, 2004, the examiner entered a Final rejection. On August 12, 2005, appellants filed an Appeal Brief. In response to appellants' Appeal Brief, the examiner mailed an Examiner's Answer on November 3, 2005. A review of the Examiner's Answer reveals that on page 6 of the Answer, the examiner entered a new ground of rejection of claims 30, 34 and

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38-45 under 35 U.S.C. § 103(a) as being unpatentable over Migliorini et al. in view of Breitler et al. "for the reasons recited in the prior office action mailed 12/17/03." However, this rejection was withdrawn in the Final rejection of June 18, 2004, thus this is a new ground of rejection.

According to MPEP § 1207.03:

37 CFR § 41.39(a)(2) permits the entry of a new ground of rejection in an examiner's answer mailed on or after September 13, 2004. . . . In such an instance where a new ground of rejection is necessary, the examiner should either reopen prosecution or set forth the new ground of rejection in the Answer. The examiner must obtain supervisory approval in order to reopen prosecution.

In addition, any new ground of rejection made by an examiner in the Answer must be approved by a Technology Center (TC) Director or designee, and prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the Answer.

Moreover, a further review of the Examiner's Answer reveals that the examiner includes the required heading of "Evidence Relied Upon," however, the examiner does not list the prior art relied upon in his rejection of claims on appeal.

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Accordingly, it is

ORDERED that the application is returned to the  
examiner to either:

(1) reopen prosecution to address the new ground of  
rejection, or

(2) to obtain approval from a TC Director or appropriate  
designee; and it is

FURTHER ORDERED that the examiner vacate the Examiner's  
Answer mailed on November 3, 2005, and submit a new Examiner's  
Answer identifying the prior art relied upon under the heading of  
"Evidence Relied Upon," and for such further action as may be  
appropriate.

BOARD OF PATENT APPEALS  
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